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Patent
Case No.: 54493US008RECEIVED
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: LANGFORD, NATHANIEL P.
Application No.: 09/821392 Group Art Unit: 1713
Filed: March 29, 2001 Examiner: Kelechi C. Egwim
Title: LOW DUST WALL REPAIR COMPOUND

OFFICIAL

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF TRANSMISSION

To Fax No.: 703-872-9306
I hereby certify that this correspondence is being facsimile transmitted
to the U.S. Patent and Trademark Office on:

November 5, 2003
Date

David B. Patchett
Signed by: David B. Patchett

Dear Sir:

This is in response to the Office Action mailed October 6, 2003. Claims 75-95 are pending.
Claims 75-95 were restricted under 35 USC § 121 as follows:

- I. Claims 75 and 76 are said to be drawn to a drywall joint compound comprising mineral oil as a dust reducing additive classified in Class 524, subclass 1+;
- II. Claims 77-80 are said to be drawn to a drywall joint compound comprising vegetable oil as a dust reducing additive classified in Class 524, subclass 1+;
- III. Claims 81 and 82 are said to be drawn to a drywall joint compound comprising petroleum oil as a dust reducing additive classified in Class 524, subclass 1+;
- IV. Claims 83 and 84 are said to be drawn to a drywall joint compound comprising saturated oil as a dust reducing additive classified in Class 524, subclass 1+; and
- V. Claims 85-95 are said to be drawn to a drywall joint compound comprising a combination of at least two oils as the dust reducing additive classified in class 524, subclass 1+.

Election

In response, Applicant elects Group III, with traverse.

Reconsideration and withdrawal or modification of the restriction requirement is respectfully requested for the reasons below.

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The Restriction Requirement states that inventions I-V are unrelated. The Restriction Requirement further states that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. In the instant case, the inventions are said to not be disclosed as capable of use together and they have different modes of operation. This is erroneous.

Elected claim 81 is directed to a drywall joint compound including a dust reducing additive comprising "oil derived from petroleum." Claim 75 is directed to a drywall joint compound including mineral oil as a dust reducing additive. Mineral oil is a type of oil that can be derived from petroleum. In addition, claim 83 is directed to a drywall joint compound including a dust reducing additive comprising saturated oil. Saturated oils may be derived from petroleum and mineral oil may be a saturated oil. Thus, Applicant believes that Group I (claims 75, 76), Group III (claims 81 and 82) and Group IV (claims 83 and 84) are related.

Applicant submits that Groups I, III, and IV and the associated claims are so interrelated that a search of one group of claims will reveal art to the others. Moreover, Applicant notes that each of the groups is classified in the same class (524) and subclasses (1+).

Were restriction to be effected among the claims in Groups I, III, and IV, a separate examination of the claims in Groups I, III, and IV would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of patentability of all the claims of Groups I, III, and IV would have to be as rigorous as when only the claims of Group III were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicant submits that if restriction were to be effected among the claims in Groups I, III, and IV, it would place an undue burden by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting three applications and maintaining three patents.

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Conclusion

Applicants have elected Group III. Continued prosecution of this application is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723. The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

November 5, 2003
Date

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